

In re Appln. of Lucas et al.
Application No. 10/085,890
Reply to an Advisory Action of August 14, 2003

Remarks

An Advisory Action was issued on August 14, 2003. The Advisory Action repeated the rejection of claims 1, 2, 4, 5, 9-11, and 13 under 35 USC 102(b) as anticipated by U.S. Pat. No. 5,254,635 to Stevenson et al. ("Stevenson '635"). The Advisory Action also repeated the rejection of claims 6-8 under 35 USC 103(a) as obvious over U.S. Pat. No. 5,254,635 to Stevenson et al. in view of U.S. Pat. No. 4,695,609 to Stevenson. The Advisory Action states that Stevenson '635 teaches the combination of a liquid polyisoprene emulsion, sulfur, a thiuram and a xanthogen. The Advisory Action goes on to state that Stevenson '635 is an enabling reference because it includes sulfur in column 4, lines 35-37 and may be in latex form, as included in column 5, lines 6-12.

The Advisory Action continues on to state that Applicant has not provided evidence that the composition claimed in this application cannot be made using the disclosure of Stevenson '635. The Advisory Action also argues that Applicant has not provided evidence that the scope of Stevenson '635 does not include the combination of the claimed elements to make a stable, working emulsion. The Examiner specifically requested in the Advisory Action that Applicant elaborate on the relevance of Applicant's statement that Stevenson '635 does not include the claim limitations in the same order as presented in the claims of the application. The Examiner states that the order in which the limitations of a claim are presented in a reference is irrelevant in a patentability determination. The Advisory Action claims that the method of forming the polyisoprene article is not relevant to the issue of patentability of the article itself. The Advisory Action asserts that the examples in Stevenson are merely examples of the invention and do not represent the entire scope of the invention disclosed by the '635 patent.

Finally, the Advisory Action rejects Applicant's argument regarding the rejection of claims 6-8 under 35 USC 103(a), stating that it is based on Applicant's arguments relating to the 35 USC 102(b) rejection. The Advisory Action states that this argument is unpersuasive.

The Advisory Action incorrectly states the law of anticipation. Not only must a reference contain each and every element of the claimed invention to anticipate, it must also (1) enable one of skill in the art to make and use the invention and (2) include the elements in the same relationship to one another as claimed by Applicants to evidence anticipation. These two requirements for an anticipating reference both reflect the same idea: the reference must allow the reader to pick out and assemble the elements of the claimed invention to create the claimed composition without the benefit of hindsight.

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First, Applicant submits that the Stevenson '635 reference is not an enabling reference for the invention claimed by Applicant. The Advisory Action argues that a mere mention of each of the elements claimed by Applicant in the Stevenson '635 patent is enough to show enablement. This is simply not true. The following two examples illustrate, by way of analogy, why the Stevenson '635 patent is not enabled for latex emulsion compositions. First, it is known that an equal amount of sour cream may be substituted where a recipe calls for plain yogurt. A recipe that lists plain yogurt as an ingredient, but mentions that sour cream may be used in its place is enabling because the substitution does not alter the product of the recipe, including how the finished product tastes. The second example is a recipe that calls for brown sugar but mentions that white sugar may be used in its place. This reference is not enabling because it does not disclose that a small amount of molasses must be included with the white sugar to substitute for brown sugar. As a result, simple substitution of the white sugar for brown sugar will not yield the same taste result from the recipe without the molasses.

While the recipe example is less complex than the invention of this application, the analogy illustrates why the Stevenson '635 patent is not enabling. The Stevenson '635 patent does not explain what additional "ingredients" must be included with the latex for successful creation of the desired product with the other materials in the invention. The Stevenson '635 patent calls for dry rubber in all of the embodiments shown in the specification and mentions that latex may be used as a substitute. However, like the brown sugar example missing the molasses information, the Stevenson '635 patent is missing information on how to effectively accomplish the substitution of latex for dry rubber. An effective substitution requires not only different processes, but also a specific pH range in which a stable emulsion is created to make the desired product and the addition of ethoxylated cetyl/stearyl alcohol, all of which are disclosed in Applicants' specification to enable use of the invention. Because the Stevenson '635 patent lacks this information, the '635 patent is not enabling.

Second, there must be identity in the arrangement of the elements in the claim and in the reference. This means that if the claim invention includes A, B, C, and D together, then the 35 U.S.C. 102 reference must also include A, B, C, and D together. If the 102 reference does not include A, B, C and D together in a way that shows the reader how to make and use A, B, C and D to create the invention as claimed in the application, it cannot be an anticipatory reference. The discussion below explains in detail why the Stevenson '635 patent, while containing the words of all the elements of Applicants' invention does not comply with the subtleties required to be a valid prior art reference for this invention.

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Contrary to the arguments in the Advisory Action, the scope of the Stevenson '635 patent clearly does not include the making of the claimed invention as a stable emulsion. An important component of creating a stable emulsion for Applicants' invention lies in the use of the materials at the proper pH and the inclusion of ethoxylated cetyl/stearyl alcohol. Without the proper pH or the ethoxylated cetyl/stearyl alcohol, the emulsion will not be stable and cannot form a latex article. The materials included in the claims of Applicants' invention do not appear with a latex emulsion anywhere in the Stevenson '635 patent. Mere mention of latex in the Stevenson '635 patent without using latex with the other materials to make a formulation is not enough to anticipate Applicants' invention. The law of anticipation requires in-depth inquiries into the arrangement of the elements in the reference (here, including latex, sulfur, a thiuram and a xanthogen together) and whether or not the reference is enabling (here, including the essential pH information and the ethoxylated cetyl/stearyl alcohol). The scope of the Stevenson '635 patent simply does not extend to limitations it does not mention, for example, stable latex formulations.

In answer to the Examiner's question regarding the relevance of the order of the limitations of a claim, Applicants submit that the order of the limitations in the claims is entirely relevant to the usefulness of the reference as prior art. To anticipate, the elements must be arranged as in the claim of the application. The application arranges the elements of liquid latex, sulfur, thiuram and xanthogen all together in a continuous, proximate manner. The order of these elements in the Stevenson '635 patent is not at all connected, and each element must be extracted from separate parts of the specification and claims of the Stevenson '635 patent in order to find them, akin to a "Where's Waldo" of claim elements. See paragraph 15 of Paper 6. One could read a short story and pick a word off every page to form a complete sentence, but that does not mean that the short story discloses that particular sentence. The same is true for claim elements. The combination of elements taught in Applicants' claim is not present in the Stevenson '635 patent, and as a result the Stevenson '635 patent does not enable the combination of these elements in one composition. Consequently, the Stevenson '635 patent cannot serve as a proper prior art reference.

Finally, contrary to the assertions made in the Advisory Action, the examples in Stevenson only represent the scope of the invention to the extent that they enable one of skill in the art to make and use the invention. The scope of the Stevenson '635 patent does not viably include latex emulsions because the mere mention of the use of latex is not enough to provide an enabling reference. The Stevenson '635 patent does not enable one of skill in the art to make

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and use the invention of this application because neither the critical pH factor nor the ethoxylated cetyl/stearyl alcohol are disclosed in the patent. None of the examples include a latex emulsion or the use of ethoxylated cetyl/stearyl alcohol, and certainly none include an indication of the proper pH at which the formulation must be created in order to form a stable emulsion.

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this PRELIMINARY AMENDMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on September 26, 2003, in an envelope as "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 CFR 1.10, Mailing Label Number EF366672985US, addressed to: Mail Stop RCE, Commissioner for Patents, Alexandria, Virginia 22313-1450.

Carlos Coronado

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